Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte RAJENDRA KUMAR
and ALAN H. KARP

_____

Appeal No. 96-2693
Application 08/018,972[1]

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ON BRIEF

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Before JERRY SMITH, FLEMING, and HECKER, Administrative Patent
Judges.

HECKER, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of

claims 1 and 3 through 12. Claims 13 through 20 have been

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[1] Application for patent filed February 18, 1993.

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allowed. Claim 2 has been canceled.

Appellants' invention relates to a technique for

optimizing performance of a portable software program for use

on different computers. The invention enables a single

version of the software to execute at its optimal speed on

each of the different computers. It can survive hardware

changes and computer system upgrades.

On page 4 of the specification and Figure 1, Appellants

disclose that the portable software queries a computer at 10

for its hardware attributes at run-time. Once the software

knows the hardware attributes of the computer, the software

optimizes at 12 at least a portion of the code of the

software. Once optimized, the code may be executed at 14 by

the computer.

Independent claim 1 is reproduced as follows:

1.   A method for improving efficiency of execution of a
portable application program by different computers, said
method comprising the steps of:

(a) reading, by the portable application program at
run-time for the portable application program in one of the
different computers, at least one hardware attribute of the
one of the different computers from a hardware attributes
storage area internal to and associated with the one of the

different computers by executing a load hardware attribute
instruction within the portable program;

      (b) optimizing, by the portable application program,
performance of at least a portion of the portable application
program for the one of the different computers based on the at
least one hardware attribute read in step (a); and

      (c) thereafter executing at least the portion of the
portable application program optimized in step(b).

The references relied on by the Examiner are as follows:

PKZIP Create/Update Utility Version 2.04c, December 28, 1992

(PKZIP).

The Microsoft Windows Resource Kit, 1992 Microsoft Corporation

(MWRK).

Claims 1 and 5 through 12 stand rejected under 35 U.S.C.

§ 102 as being anticipated by PKZIP Create/Update Utility

Version 2.04c.

Claims 3 and 4 stand rejected under 35 U.S.C. § 103 as

being unpatentable over PKZIP Create/Update Utility Version

2.04c in view of The Microsoft Windows Resource Kit.

Rather than repeat the arguments of Appellants or the

Examiner, we make reference to the brief and the answer for

the respective details thereof.

OPINION

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After a careful review of the evidence before us, we affirm the 35 U.S.C. § 102 and 35 U.S.C. § 103 rejections. It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. See In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). "Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention." RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984), *cert. dismissed,* 468 U.S. 1228 (1984), citing Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983).

Appellants argue on page 7 of the brief that PKZIP detects only one [hardware] attribute while Appellants' claims 1 and 7 claim "reading at least one hardware attribute". As pointed out by our reviewing court, we must first determine

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the scope of the claim. "[T]he name of the game is the

claim." In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d

1523,1529 (Fed. Cir. 1998). While "only one" is not the same

as "at least one", we find that "only one" meets the scope of

the claim language of "at least one".

Appellants argue on page 7 of the brief that claims 1 and

7 both claim "reading ...from a hardware attributes storage

area", and that PKZIP does not teach where the CPU type is

being read from. The Examiner replies on pages 5 and 6 of the

answer that it is inherent in how PKZIP operates. We find

that the CPU type (i.e. attributes) must be stored in a CPU

storage area in order for PKZIP to "detect what type of CPU it

is being run on"

(PKZIP at page 3).

Appellants further argue that claims 1 and 7 both claim

"reading...at run-time...hardware attribute...by executing a

load hardware attribute instruction" and that PKZIP does not

teach or disclose executing a load hardware attribute

instruction. Appellants state "But no such instruction exists

in the 80x86 instruction set." (brief at top of page 8). We

find that no such instruction is required to exist in the

80x86 CPU. Appellants' disclosure recites that the claimed

portable program 20 contains the Load Hardware Instruction 22

(page 7 lines 20, 21 and

Figure 2). Just as Appellants' claimed program contains the

Load Hardware Instruction, so must the PKZIP program in order

to detect the CPU attributes.

In the last paragraph of page 8 of the brief, Appellants

indicate that "[c]laims 7, 11 and 12 further recite that 'the

hardware attributes storage area being a non-volatile,

semiconductor memory device or digital logic hardwired at

fabrication'". They go on to argue that "PKZIP does not

disclose how CPU type is being determined. ... Therefore, it

is inherent that PKZIP does not disclose the storage area for

hardware attributes, much less the type of storage area." We

agree with the Examiner that it is inherent in PKZIP, in

determining the CPU type, PKZIP is relying on a non-volatile

semiconductor storage area of the CPU to obtain the CPU's

attributes, otherwise the CPU would not be able to

remember(e.g. memory) and respond with its attributes.

Therefore, upon considering PKZIP as a whole, we find

that PKZIP does disclose the method of claims 1 and 7. Since

claims

5 through 12 stand or fall with claims 1 and 7 we find that

PKZIP anticipates these claims as well.

The Examiner has set forth a ***prima facie*** case of

obviousness under 35 U.S.C. § 103 for claims 3 and 4. It is

the burden of the Examiner to establish why one having

ordinary skill in the art would have been led to the claimed

invention by the reasonable teachings or suggestions found in

the prior art, or by a reasonable inference to the artisan

contained in such teachings or suggestions. In re Sernaker,

702 F.2d 989, 995, 217 USPQ

1, 6 (Fed. Cir. 1983).

With regard to the rejection of claims 3 and 4 under

35 U.S.C. § 103 as being unpatentable over PKZIP in view of

The Microsoft Windows Resource Kit (MWRK), Appellants argue at

the bottom of page 9 of the brief that the teachings of the

prior art itself should suggest the claimed subject matter and

that the Examiner's prior art does not suggest the claimed

invention. The Examiner states in the final rejection that

one of ordinary skill in the art would know that the type of

CPU (as determined by PKZIP) is not the only significant

hardware attribute of a computer system. As taught by MWRK,

plural hardware attributes should be determined before

deciding the operating mode of the MWRK software. On page 63,

MWRK automatically runs on a standard mode or enhanced mode

after determining whether the system has an 80286 CPU and 256K

of free conventional memory and 192K of free extended memory

or an 80386 CPU and 2 megabytes of memory

(256K of free conventional memory and 1024K extended memory).

Thus, just as plural hardware attributes are determined before

selecting the MWRK mode of operation, the Examiner reasons

that determining plural hardware attributes would further

enhance PKZIP in optimizing itself. PKZIP itself teaches the

use of detecting plural attributes as noted on page 1, i.e.

"80386 CPU detected, XMS version 2.00 detected, Novell Netware

version 3.11 detected, DPMI version 0.90 detected".

     With regard to Appellants' claim 4 limitation that "at

least one of the plurality of hardware attributes is

associated with cache memory resources", the Examiner notes

that MWRK teaches determining the CachedFileHandles. On page

184, MWRK teaches this entry to keep a number of files open,

"ensuring optimal performance".

In view of the foregoing, the decision of the Examiner

rejecting claims 1 and 5 through 12 under 35 U.S.C. § 102 and

claims 3 and 4 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in

connection with this appeal may be extended under 37 CFR

§ 1.136(a).

AFFIRMED

	)	
	)	
Jerry Smith		
Administrative Patent Judge	)	
	)	
	)	
	) BOARD OF PATENT	
Michael R. Fleming	)	
Administrative Patent Judge	) APPEALS AND	
	)	
	) INTERFERENCES	
	)	
Stuart N. Hecker	)	
Administrative Patent Judge	)	

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